



**Mail Stop AF**  
**PATENT**  
**1248-0674P**

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Yasuaki FUKADA et al. Conf.: 6469  
Appl. No.: 10/681,167 Group: 2854  
Filed: October 9, 2003 Examiner: A. NGUYEN  
For: TWO-SIDE IMAGE FORMING APPARATUS

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

August 5, 2005

Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached (5) Sheets.

## REMARKS

In the outstanding Official Action, the Examiner rejected 1-3, 5, and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Noguchi et al.* (USP 4,978,980); and rejected claims 4 and 6-16 under 35 U.S.C. § 103(a) as being unpatentable over *Noguchi et al.* in view of *Yasui et al.* (USP 5,839,032). Applicants respectfully traverse these rejections.

### **The Examiner Fails To Provide Any Support for the Rejection and thus Fails to Establish Prima Facie Obviousness of Claim 17**

In support of the Examiner's rejection of claim 17, the Examiner merely asserts "With respect to claims 3 and 17, Fig. 29 of Noguchi et al. shows the conventional use of a sensor (d) in the second path."

The present invention of claim 17 recites "A two-side image forming apparatus comprising a first sheet-transferring path, for use in one-side image formation, for transferring, to a printed sheet storage section via an image transcribing section, a sheet supplied from an unprinted sheet storage section; a second sheet-transferring path, connected to the first sheet-transferring path, for supplying a turned-over one-side printed sheet to the image transcribing section, an intermediate roller provided along the second sheet-transferring path; a resist roller for synchronizing a timing at which a sheet is transferred onto the first sheet-transferring path, wherein the two-image forming apparatus is controlled such that a plurality of sheets are transferred concurrently in an overall sheet-transferring path when performing two-side image forming operation, the overall sheet-transferring path including the first sheet-transferring path and the second sheet-transferring path, and a rotation of the intermediate roller is in synchronism with a resumption of rotation of the resist roller; and second sheet detection means in the second sheet-transferring path, the second sheet detection means for detecting the one-side printed sheet transferred into the second sheet-transferring path, the two-side image forming apparatus (i) stopping the one-side printed sheet that is detected, when the second sheet detection means detects the one-side printed sheet, and (ii) resuming transfer of the one-side printed sheet in a predetermined timing."

Applicants are unable to ascertain from the Examiner's rejection which elements the Examiner is relying upon to teach or suggest the first sheet transferring path, the second sheet-transferring path, the intermediate roller, the resist roller, the second sheet-detection means and the two-sided image forming apparatus as claimed, based upon the Examiners statement provided.

Applicants maintain that the cited reference fails to teach or suggest the intermediate roller, the resist roller, and the two-sided image forming apparatus (i) stopping the one-side printed sheet that is detected, when the second sheet detection means detects the one-side printed sheet, and (ii) resuming transfer of the one-side printed sheet in a predetermined timing as claimed.

For these reasons, Applicants maintain the Examiner has failed to establish *prima facie* obviousness with regard to claim 17 and, as such, claim 17 is patentable over *Noguchi et al.*

**Claim Rejections - 35 U.S.C. § 103 - *Noguchi et al./Yasui et al.***

The Examiner rejected claims 4 and 6-16 under 35 U.S.C. § 103(a) as being unpatentable over *Noguchi et al.* in view of *Yasui et al.* In support of this assertion, the Examiner merely provides support for his rejection of claim 4. The Examiner merely provides a confusing statement regarding what would be obvious with regard to only a few elements of claims 6-17 (which are not inclusive of the entire claimed invention as set forth in each of claims 6-17 and, further, claim 17 did not appear to be rejected in view of *Noguchi et al.* and *Yasui et al.*) However, the Examiner fails to particularly identify which references he is relying upon to teach or suggest each of the individual elements of the claims. As such, the Examiner has failed to establish *prima facie* obviousness and, further, Applicants cannot properly respond to these rejections as Applicants cannot ascertain which references the Examiner is relying upon to teach each of the claim elements.

Applicants maintain that *Noguchi et al.* fails to teach or suggest the intermediate roller and the resist roller for the reasons noted above with regard to claim 1. Further, the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements as noted above with regard to claim 1.

Further, the Examiner appears to admit that neither of the cited references teach or suggest “the selection of a desired period or timing for feeding a sheet from a tray or to an image forming device while the switchback means reverses the other sheet to a second path, and the selection of a desired location of the detection means on the transferring paths.” However, as the Examiner has failed to provide any properly combinable references that cure the deficiencies of the cited references, the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. §103.

**Claims Rejections – 35 U.S.C. § 103(a) – *Noguchi et al.***

In support of the Examiner's rejection of claim 1, the Examiner admits that *Noguchi et al.* fails to teach the rotation of the intermediate roller being in synchronism with a resumption of rotation of the resist roller. The Examiner asserts it would have been obvious to one of ordinary skill to provide for this missing element, presumably asserting that if this element were not present, the device would jam. Applicants respectfully disagree with the Examiner's assertions.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**The Cited Reference Fails to Teach or Suggest an Intermediate Roller**

The Examiner admits that *Noguchi et al.* fails to teach the intermediate roller being in synchronism with a resumption of rotation of the resist roller. However, the Examiner fails to provide properly combinable references that cure the deficiencies of the teachings of *Noguchi et al.* As such, the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements. For at least this reason, the outstanding rejection should be withdrawn.

**The Cited Reference Fails to Teach or Suggest a "Resist Roller for Synchronizing a Timing at which a Sheet is Transferred onto the First Sheet-Transferring Path" and "a Rotation of the Intermediate Roller is in Synchronism with a Resumption of Rotation of the Resist Roller"**

Applicants respectfully disagree that roller 504 teaches the resist roller of the claimed invention. The present invention set forth in claim 1 recites a resist roller for synchronizing a timing at which a sheet is transferred onto the first sheet transferring path. There is no teaching or suggestion in *Noguchi et al.* that indicates that roller 504 performs this function as set forth in claim 1.

Further, there is no discussion in the cited reference that discloses that the resist roller resumes rotation. There simply is no discussion of the functionality of roller 504 at all in the description of the reference. As such, Applicants maintain that *Noguchi et al.* fails to teach or suggest these claim elements. For at least this reason, Applicants respectfully request that the outstanding rejection be withdrawn.

#### **The Examiner does not Provide Proper Motivation to Support the Rejection**

The Examiner appears to indicate that it would have been obvious to one skilled in the art to provide the missing element as indicated, presumably asserting that if the element were not present, the device would jam. *Noguchi et al.* is a United States patent issued on December 18, 1990. Presumably, the device disclosed in *Noguchi et al.* satisfies all of requirements under 35 U.S.C. § 112. As such, there is a presumption that the device works. Therefore, the Examiner's assertion that if the feature was not present then the device would jam is an improper presumption. If, in fact, the device disclosed in *Noguchi et al.*, is a non-working device as asserted by the Examiner, then Applicants respectfully submit that the Examiner's citation of *Noguchi et al.*, is improper as it represents a non-working device and thus is not sufficiently enabled to teach the features as asserted by the Examiner.

#### **The Examiner Relies on Impermissible Hindsight in Support of the Rejection**

In addition to the above arguments, the Examiner admits that *Noguchi et al.* fails to teach or suggest an intermediate roller which is in synchronism with a resumption of rotation of the resist roller. In order for a *prima facie* case to exist, the prior art must suggest the desirability of the claimed invention, providing motivation to make the combination proposed by the Examiner. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ 2d 1453, 1457-58 (Fed.Cir. 1998). The level of skill in the art cannot be relied upon to provide this suggestion to combine the references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). As *Noguchi et al.* fails to teach or suggest this element, by asserting such a modification to the device disclosed in *Noguchi et al.* would have been obvious without a proper suggestion or motivation in the applied reference or elsewhere to do so, the rejection appears to rely on impermissible hindsight reasoning. As such, for at least this reason, Applicant's respectfully request that the outstanding rejection be withdrawn.

For all of the reasons set forth above, Applicants maintain that the Examiner has failed to establish *prima facie* obviousness. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2 -3, 5-8, and 12 are allowable for the reasons set forth above with regard claim 1 at least based upon their dependency on claim 1. It is further respectfully submitted that claim 17 contains elements similar to those discussed above with regard to claim 1 and thus claim 17 is not obvious for the reasons set forth above with regard to claim 1.

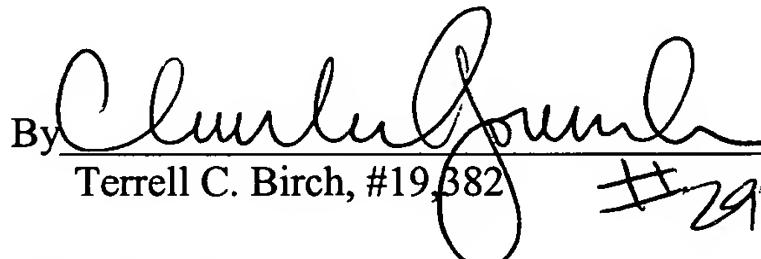
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By   
Terrell C. Birch, #19,382 #29271

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

TCB/CMV/mmi  
1248-0674P